

REMARKS

Reconsideration and allowance are respectfully requested.

Claims 1-2, 7-20 and 24-28 are pending. The claim amendments are fully supported by the original disclosure and, thus, no new matter is added by their entry.

Double Patenting

Claims 1-5 were rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1-8 of Patent 6,277,627 (the '627 patent). Applicants traverse.

The pending claims are directed to a glucose binding protein with at least one reporter group attached at one or more of positions of 10, 93 or 183. There is no reason provided in the Action for why one of ordinary skill in the art would have attached one or more reporter groups at these positions. The mutations recited in claim 12 of the '627 patent were not made to attach a reporter group.

Withdrawal of the double patenting rejection is requested.

35 U.S.C. 102 – Novelty

A claim is anticipated only if each and every limitation as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is claimed. See *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1 and 3-15 were rejected under Section 102(e) as allegedly anticipated by Amiss et al. (U.S. Patent Application 2003/0134346 or U.S. Patent 6,855,556). Applicants traverse.

It was alleged on page 6 of the Action that Amiss et al. disclose that the reporter group may be attached "throughout the length of the galactose/glucose binding protein" citing to paragraph [0034]. But this is not taught in the indicated paragraph of Amiss et al. Only positions 11, 14, 19, 43, 74, 107, 110, 112, 113, 137, 149, 152, 213, 216, 238, 287, and 292 are disclosed. It was also taught, "The reporter group may be attached to

the mutated protein or GGBPs by any conventional means known in the art.” There is no teaching in Amiss et al., however, of attaching a reporter group at any position along the length of a glucose binding protein as alleged in the Action.

Withdrawal of the Section 102 rejection is requested.

35 U.S.C. 103 – Nonobviousness

To establish a case of prima facie obviousness, all of the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03.

Claims 1-15 were rejected under Section 103(a) as allegedly unpatentable over Hellinga (WO 99/34212 or the ‘627 patent). Applicants traverse.

As noted above, the pending claims are directed to a glucose binding protein with at least one reporter group attached at one or more of positions of 10, 93 or 183. The cited documents do not teach or suggest these specific positions for attaching reporter groups. And there is no reason provided in the Action for why one of ordinary skill in the art would have attached one or more reporter groups at these specific positions.

Withdrawal of the Section 103 rejections is requested.


Conclusion

Having fully responded to all of the pending objections and rejections contained in this Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect.

Respectfully submitted,

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